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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,598	05/30/2001	Domenic Cosentino	COSE3001/JEK	4955
23364	7590	12/29/2004	EXAMINER	
BACON & THOMAS, PLLC 625 SLATERS LANE FOURTH FLOOR ALEXANDRIA, VA 22314			TORRES VELAZQUEZ, NORCA LIZ	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 12/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,598

Applicant(s)

COSENTINO, DOMENIC

Examiner

Norca L. Torres-Velazquez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-15 have been considered but are moot in view of the new ground(s) of rejection.
2. The Examiner had equated the recessed area taught by the Ponchaud et al. reference (US 5,604,006) to the presently claimed opening. However, upon consideration of Applicant's remarks and the definition of the term "opening" in the Merriam-Webster's Collegiate Dictionary, tenth edition; the Examiner concludes that the Ponchaud et al. reference fails to teach this limitation. The term "opening" is defined in terms of being an aperture, a hole. The 35 U.S.C. 103(a) rejection over PONCHAUD in view of COSCIA of claims 1-15 has been withdrawn.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1- are rejected under 35 U.S.C. 103(a) as being unpatentable over NUSSBAUM (US 4,830,892) in view of PONCHAUD et al. (US 5,604,006).

PONCHAUD et al. (US 5,604,006) in view of COSCIA et al. (US 4,781,952).

NUSSBAUM relates to a molding strip having an integrally formed insert with indicia. The molding strip includes an elongated plastic strip having an aperture formed therein. An insert is positioned in the aperture. (Abstract) The reference teaches that their invention can be

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used as fascia trim, especially for automotive vehicles. (Col. 1, lines 9-12) The reference shows a molding strip 10 that may be in the form of a substrate 18 having a metallized film 20 secured or bonded thereon. Substrate 18 can comprise polyvinylchloride or any other conventional material suitable for the intended use of molding strip 10. Indicia 14 further includes a clear or tinted transparent plastic overlayer 22. The insert 24 is positioned within an aperture formed in the molding strip. The reference teaches that the insert 24 can be fabricated from polyvinylchloride or other suitable material. (Col. 2, lines 42-68 through Col. 3, lines 1-5) NUSSBAUM further teaches that the insert member 24 is of a similar size and shape to aperture 26. (Col. 3, lines 26-28)

The Examiner equates the molding strip 10 with an aperture 26 to the main plate of the present invention with an opening, and insert member 24 to the insert plate of the present invention. It is noted that the material and/or finish of the molding strip and the insert member of the reference are different.

However, the reference is silent to the use of a backing member that comprises at least one adhesive element on a surface opposite a surface upon which the main plate is mounted.

PONCHAUD et al. teaches a composite article 10 that includes a decorative insert, inlay, foil or preform 12 having an exterior surface 14 and an interior surface 15 (Fig. 3) to which is firmly secured a thermoplastic body 18. The label 16 includes a thermoplastic layer 20. The label 16 is recessed into the exterior surface 14 of the decorative insert 12, and can either be partially recessed into the decorative insert 12 or fully recessed into the decorative insert 12. (Column 2, lines 63-67 through Column 3, lines 1-25) The decorative insert 12 comprises a thin sheet of thermoplastic material and the reference further teaches that it can also comprise a

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thermoplastic substrate, which has a wood grain print on its exterior surface. (Column 4, lines 23-43) It is the Examiner's interpretation that the composite article taught by the reference provides a similar product to the one taught by NUSSBAUM and provides a thermoplastic body 18 that equates to the backing member of the present invention.

However, PONCHAUD et al. fails to specifically teach the use of an adhesive element on the backing member on a surface opposite a surface upon which the main plate is mounted.

COSCIA et al. is directed to a decorative article for use in automobile surfaces such as those in the passenger compartment. (Column 1, lines 13-20) The reference teaches the use of various substrates and teaches that means for mounting may include a layer of adhesive material and teaches the use of a pressure sensitive adhesive. (Column 3, lines 10-14)

Since the references are directed to decorative articles for use in trim applications for automobiles, the purpose disclosed by COSCIA et al. and PONCHAUD et al. would have been recognized in the pertinent art of NUSSBAUM.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the molding strip of NUSSBAUM and provide it with a backing member (thermoplastic body 18) such as that taught by PONCHAUD et al. and further provide it with an adhesive element/layer such as pressure sensitive adhesive with the motivation of providing a means for mounting the molding strip article to the automobile surface without the use of fasteners as disclosed by COSCIA et al. (Refer to Column 1, lines 17-19 and Column 3, lines 10-14).

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Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

PYNENBURG et al. (US 6,129,969) – it relates to a foam sign made from a laminated substrate and several cuts out die cut from the substrate. In Figure 4, the reference shows base (11), a cut-out (13), a spacer (28) and a backing (30). The reference teaches that the cut out 13 is disposed within and above the base 11. The cut out 13 and/or the spacer 28 may be removably attached within base 11. (Refer to Col. 4, lines 20-48) The reference teaches that the cut outs 13 are force fitted into the cavities 15 to fit snugly into the cavity. The reference further teaches that the base 11 and the cutouts 13 both are the same material. (Col. 2, lines 51-65) The PYNENBURG et al. reference differs from the present invention in that the second surface of the cutouts are not mounted on the backing member but into the spacer material.

SCHILLING et al. (S 5,656,109)

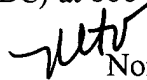
WAUGH et al. (US 4,612,075)

BARBERIS (US 4,904,511)

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norca L. Torres-Velazquez whose telephone number is 571-272-1484. The examiner can normally be reached on Monday-Thursday 8:00-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Norca L. Torres-Velazquez
Examiner
Art Unit 1771

December 22, 2004